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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,229	09/12/2003	Joseph R. Hedrick	0112300-612	6841

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BELL, BOYD & LLOYD LLP		
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EXAMINER	
SAGER, MARK ALAN	

ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
07/20/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

## Office Action Summary

Application No.

10/661,229

Applicant(s)

HEDRICK ET AL.

Examiner

M. A. Sager

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8/28/06, 1/3/07, 5/2/07, 4/12/07, 4/26/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 94-114 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 94-114 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/12/07, 8/28/06, 4/26/06</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Regarding notice of abandonment (drafted date March 14, 2007), mailed April 26, 2007, the examiner apologizes for any confusion but that action was not to have been mailed and despite inter-office assurance that it was not being mailed, it is unfortunate to have become of record. The mailing of the notice of abandonment and any confusion to record that it may have caused, was unintentional.

### ***Priority***

2. It is noted that this application appears to claim subject matter disclosed in prior Application No. 10/795337, filed 2/27/01. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date

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of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required.

Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

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3. The benefit claim filed on 8/28/06 was not entered because the required reference was not timely filed within the time period set forth in 37 CFR 1.78(a)(2) or (a)(5). If the application is an application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a nonprovisional application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the reference to the prior application must be made during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). If applicant desires the benefit under 35 U.S.C. 120 based upon a previously filed application, applicant must file a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(a)(3) or (a)(6). The petition must be accompanied by: (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted); (2) a surcharge under 37 CFR 1.17(t); and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. At present, no petition has been received regarding delay being unintentional and applicant is reminded that any application filed after November 11,

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2000 which submits an untimely benefit claim without a granted petition for unintentional delay during prosecution such as prior to payment of issue fee, the benefit claim is non-enforceable.

4. Also, regarding Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c), Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows: With respect to both 09/795337 and 10/923568, each lacks a common inventor with instant application and each lacks a relationship designation of application as continuation, divisional or continuation-in-part to instant application in that 'related' is improper as being incomplete relationship designation. There is no relationship defined as 'related' with respect to a proper benefit claim. 35 USC 120, 37 CFR 1.78. Also, with respect to 10/923568, the '568 application is not a prior filed application to instant application and thus a benefit claim to '568 application is improper as not being prior to instant application.

***Claim Rejections - 35 USC § 103***

5. Claims 94-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto (5628685) in view of Raven (5429361). Takemoto discloses a gaming device and method (2:5-5:44, figs. 1-9) comprising all claimed steps/features including game operable upon a wager (6:46-57), a housing defining a card slot to receive a data card (7:61-8:19, ref 11, 20, 24), a data reader supported by the housing and data writer supported by the housing (7:61-8:19, ref 24-26), a thermal energy supplier supported by the housing and a thermal energy director coupled to the thermal energy supplier, operable to direct thermal energy toward a received data card (8:5-7), a processor coupled to thermal energy supplier/director (ref 40, 110), instruction executable by the processor to operate the game for a player who inserted the data card into the card slot (8:29-34,



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11:5-7, fig. 5-6, 9), to cause the data writer to change machine-readable data stored by the data card including after a designated event occurs such as selection of adjustment switch to cash-out wherein the machine-readable data includes credit data, fund data, fund tracking data, or cash data (7:3-38, 7:57-8:19, 29-34, 9:23-30, 49-55, 11:29-59, ref 32), writing a plurality of computer readable instructions which are executable by processor (figs 1-9, esp. 5-6, 9) to process game data associated with a game operable upon a wager by a player (supra), cause machine readable data to be stored by a data card received from a player (7:11-19, 8:8-11) and cause the thermal energy director to cause a human readable symbol to be produced and viewable on the received data card [after a designated event occurs] the human-readable symbol indicating at least a portion of the machine readable data stored by the data card such as cash data (7:11-19, 11:50-53) and to cause heat to be directed toward the data card to cause plurality of symbols to be viewable on received data card where symbol is selected from text, a numeral, and illustration (7:11-19, 11:50-53), but lacks instruction to enable processor to access over a network player-specific information stored in a data storage device (clm 94), the human-readable symbol indicating at least a portion of the player-specific information (clm 94, 102), wherein the data storage device stores a plurality of different sets of player-specific information each one of the sets being associated with a different player (clm 95, 105), to access the set of player-specific information associated with the player who inserted the data card (clm 97, 107), part of a player tracking system (clm 100, 108), player database and player-specific information includes data associated with a plurality of different player profiles (clm 101), instruction to enable processor to access over a network player-specific information stored in a data storage device the player specific information including data associated with at least one player profile (clm 102), a player

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profile (clm 109), access over a network data associated with the player profile of the player (clm 109), human readable graphics indicating at least a portion of the data associated with the player profile (clm 109), causing processor to access over network a data storage device which stores player specific data associated with the player and player specific data associated with a plurality of other players (clm 111), access a player tracking module (clm 112).

In brief, Takemoto '685 discloses a data carrier that is reusable pre-paid card due to thermal printing of cash data as symbols stored thereon via bar code (machine readable) and digits (human readable) and includes a central computer (ref 50) but lacks player profile(s) in a database of player accounts, access over network to player profile or to player tracking [module] and printing player specific information on data card such as player name or player account number. Regarding a player database/profile, network access to player database/profile and player tracking, it is notoriously well known by an artisan at a time prior to invention that a gaming club/hall track players game play via player club card for marketing and bonus redemption to maintain player loyalty to their club/hall and to provide a data storage device that maintains a plurality of player specific data so as to associate a player's specific data with a particular player that may at least include address, name, club/hall account number and possibly financial data such as a financial/bank account from which to draw funds or a credit value as pre-paid amount stored in player account. As evidence thereto, Raven discloses a card with processor and memory that tracks/stores player use, player account and credit balance that is cross-checked over a network to access player profile so as to verify validity of card and value on card (10:44-11:62, esp. 11:47-62) whereby the player card is in communication with a player tracking module (abstract, 2:16-19, 47-49, 4:49-51, 61, 5:25-27, 9:61-68, 10:34-35) in gaming



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club/hall system of game devices so as to obtain frequency of use or play for marketing and comp bonus purposes to maintain/encourage loyalty to the gaming club/hall. Thus, it would have been obvious to an artisan at a time prior to the invention to add instruction to enable processor to access over a network player-specific information stored in a data storage device, wherein the data storage device stores a plurality of different sets of player-specific information each one of the sets being associated with a different player, to access the set of player-specific information associated with the player who inserted the data card, part of a player tracking system/module, a player database and player-specific information includes data associated with a plurality of different player profiles, instruction to enable processor to access over a network player-specific information stored in a data storage device the player specific information including data associated with at least one player profile, the player having a player profile, access over a network data associated with the player profile of the player, causing processor(s) to access over network a data storage device which stores player specific data associated with the player and player specific data associated with a plurality of other players as notoriously well known or as taught by Raven to Takemoto to permit tracking of player activity for marketing and allow comp bonus to player based on accumulated frequency of play data so as to maintain or encourage club loyalty and to store player data in database of player accounts for access to cross check for validity for improved security and to prevent fraud.

Regarding printing player specific information on data card, the human-readable symbol indicating at least a portion of the player-specific information and human readable graphics indicating at least a portion of the data associated with the player profile, it is notoriously well known for identification or charge, credit or debit card to include either printed

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or embossed user name and/or account number and generally both where at least account number is also stored on magnetic strip or memory chip to access user account over network. The printed matter of name and/or account number on data card is provided for a visual reference of owner of card or account number of user to verify ownership so as to provide security to prevent unauthorized user who is not owner from claiming ownership (i.e. stealing card or fraudulent use by non-owner). Takemoto lacks discussing printing player specific information on data card (supra). The lack of discussion in Takemoto does not teach away from adding printing of player specific data on data card to increase security especially in consideration when data is stored on data card pertaining access over network to a user/player account as taught by Raven (supra) and since the standard of patentability is what the combination taken as a whole at a time prior to the invention suggests to an artisan, as discussed next. Also, Raven lacks discussing printing player specific information on data card such as player name or account number printing user/player data on data carrier is so conventional as to be hornbook engineering that it is deemed implicit within Raven. As evidence only that printing player specific information on data carrier/card is conventional, note discussion above regarding credit or charge or debit card or, also see Bergeron (4764666, 6:11) or Benson (5814796, 3:59-61) or Saunders (6012832, 8:5-8, 30-34). Raven also includes storing credit on card and accessing player account over network (sic); thus, Raven either implicitly includes printing player specific information on data card such as player name and/or account number where at least account number is also stored on card electronically to permit electronic communication over network to access player account from game machine for the added security or, it would have been obvious to an artisan at a time prior to the invention to add printing player specific information on data card, the human-readable symbol indicating at

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least a portion of the player-specific information and human readable graphics indicating at least a portion of the data associated with the player profile as known in data carrier art to Raven for increasing security to visually verify ownership and to prevent another person falsely claiming ownership. It is reiterated as discussed above, Takemoto includes printing on data card at game machine that includes printing either on blank stock or on player held card. Thus, the combination of Takemoto in view of Raven either implicitly includes printing player specific information on data card such as player name and/or account number where at least account number is also stored on card electronically to permit electronic communication over network to access player account from game machine for the added security or it is held obvious to add printing player specific information on data card such as player name and/or account number where at least account number is also stored on card electronically to permit electronic communication over network to access player account from game machine for the added security (supra). Therefore, in this instance, when Takemoto in view of Raven is taken as a whole at a time prior to the invention, the combination suggests a gaming device or method including printing player specific information on data card such as player name and/or account number where at least account number is also stored on card electronically to permit electronic communication over network to access player account from game machine for the added security.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 94-114 have been considered but are moot in view of the new ground(s) of rejection.

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7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

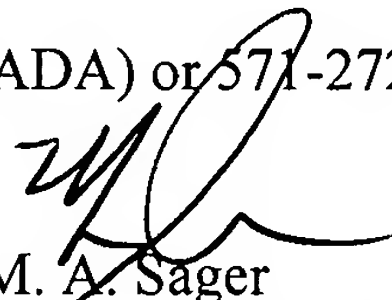
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



M. A. Sager  
Primary Examiner  
Art Unit 3714

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